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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Interactive Logistics, Inc.

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Serial No. 76175597

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Norman E. Lehrer for Interactive Logistics, Inc.

John D. Dalier, Trademark Examining Attorney, Law Office 105 (Tom G. Howell, Managing Attorney).

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Before Simms, Cissel and Hanak, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 5, 2000, applicant, a corporation operating and existing under the laws of the state of Delaware, applied to register the mark "NAVITRACE" on the Principal Register for services identified as "computerized on-line services in the field e-commerce supply chain activities for providing information relating to order status, order tracking and tracing and activity/ordering history." The stated basis for filing the application was applicant's assertion that it possessed a bona fide

intention to use the mark in connection with rendering these services in commerce.

The Examining Attorney advised applicant that the recitation of services was not acceptable because it is indefinite. The Examining Attorney required amendment to the recitation of services, and suggested following: "computerized tracking and tracing of packages in transit, in International Class 35."

Applicant responded by amending the recitation of services to "computerized on-line services, namely, providing web access to information relating to supply-chain activity including shipment status and history." Applicant argued that the language the Examining Attorney had suggested was "too narrow," although it was not explained what the suggested recitation left out. Applicant further argued that the amended recitation of services adequately specifies the activities in connection with which applicant intends to use the mark.

The Examining Attorney found the amended recitation of services to be indefinite, and maintained and made final the requirement for an acceptable recitation of services. Noting that the Trademark Rules require that an application must specify the particular services in connection with which the applicant uses, or intends to use, the mark, he

argued that the word “including” is indefinite, and suggested that applicant substitute “namely” for it. Additionally, he stated that the words “providing web access” are inappropriate for the services applicant appears to intend to provide under the mark, contending that “access” is used for Internet service providers, i.e., businesses which connect computer users to the Internet, rather than by entities which provide content or information by means of computers. He suggested that applicant adopt the following identification, if accurate: “providing supply-chain activity information to others, namely, computerized tracking and tracing of packages in transit or that were in transit,” in Class 35.

Applicant timely filed a notice of appeal. Both applicant and the Examining Attorney filed briefs on appeal, but applicant did not request an oral hearing before the Board. Accordingly, we have resolved this appeal based upon careful consideration of the record before us in this application, the written arguments of applicant and the Examining Attorney, the statute and the Trademark Rules of Practice.

Trademark Rule 2.132(a)(6) makes the requirement that an application must include “[a] list of the particular

goods or services on in or in connection with which the applicant uses or intends to use the mark."

In the case at hand, although the Examining Attorney has identified and discussed in detail the specific language in the application, as amended, which he thinks runs afoul of the requirement for specificity in a recitation of services, applicant has been less than clear about why it is unwilling to be more specific about what the services it intends to render under the mark will actually be. For example, applicant argues that just because the Examining Attorney claims that "providing web access" is normally used to identify only the services of Internet service providers, rather than those of information content providers, "it is submitted that this does not make the use of the term improper." (Brief, p.2) Although applicant argues that "others in this field would clearly understand the nature of the services," applicant does not support this conclusion with either evidence or persuasive reasoning, nor does applicant respond directly to the Examining Attorney's argument.

Similarly, the Examining Attorney explained why the term "including" implies that only some of the services which follow this word are being named, whereas the word "namely" would be understood to proceed a list of the

specific services which are encompassed within the broad terminology preceding the word. Rather than responding directly to the Examining Attorney's argument, applicant simply states that it fails to see how use of the term "including" renders its recitation of services indefinite, and concludes that it does not understand how "namely" is any more specific than "including."

We hold that the requirement for a more definite recitation of services is well taken in this case. In particular, we agree with the Examining Attorney that the word "including" is unacceptably broad. As the Examining Attorney points out, the service of providing information by means of the Internet is specified in the class or classes of the information being provided. For example, providing information about business services belongs in Class 35, whereas providing information about financial services is properly classified in Class 36. By employing the term "including" in the context of its recitation of services, applicant implies that its information services are not limited to or restricted to supply-chain activity information about shipment status and history. As it is written, applicant's recitation of services encompasses providing information with respect to services that fall outside of the class for shipment status and history.

Information about procurement data or warranty information, for example, are encompassed within applicant's language. In that this recitation could include services in these other classes, it is unacceptable.

"Providing web access to information" is also unacceptable in connection with applicant's services. As applicant describes them in the context of its arguments, its services consist of providing information, rather than providing access to the Internet. As such, the recitation of services, as amended, actually misdescribes applicant services.

It is unclear from both the record and applicant's arguments why applicant chose not to respond directly to the Examining Attorney's arguments or to correct this problem. As the Examining Attorney points out, applicant has made no serious attempt to challenge the conclusion that the recitation is overly broad. Instead, applicant simply states that it "fails to see how its identification of services is any less specific or definite than the language suggested by the Examining Attorney." (Brief, p.2) This argument is an insufficient basis upon which to hold that the Examining Attorney has abused his discretion by requiring applicant to be more specific in describing the

services with which it intends to use the mark it seeks to register.

Decision: The requirement for a more definite recitation of services is affirmed.